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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,228	06/27/2001	Gal Trifon	65346/JPW/JHB	4919
7590 Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			EXAMINER BEKERMANN, MICHAEL	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 08/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/893,228	Applicant(s) TRIFON ET AL.	
	Examiner Michael Bekerman	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 14-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 14-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/4/2007 has been entered.

Affidavits

2. It is unclear whether the Affidavit filed by Applicant contains enough information to obtain a December 22, 1999 priority date. However, new art has been applied that predates December 22, 1999, so this point is now moot.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-3, 5-10, 14-18, 24, 26, 27, 31-37, 40-44, and 46-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Merriman (U.S. Patent No. 5,948,061).** Merriman teaches a system and method for generating messages to a website browser that includes all of the limitations recited in the above claims.

Regarding claims 1, 3, 7-10, 26, 33-37, 47, and 48, Merriman teaches sending a web page in conjunction with a software component for enabling burst messages (Column 2, Lines 19-23). The embedded reference is the software component, and the embedded reference is indeed sent along with the web page. Merriman also teaches determining a user's IP address (identification) for ad-targeting purposes (Column 5, Lines 13-15). Merriman further teaches sending data required for generating a burst message to the web terminal (Column 2, Lines 23-26). The advertisement inherently contains image code and html code (content code) that is needed to execute (display) the message.

Regarding claims 2, 6, 14, 27, 32, 40, Merriman teaches code for allowing a user to interact with the burst message (click-through) (Column 3, Lines 64-67).

Regarding claims 5 and 31, data must inherently be stored in a computer to be rendered (whether that storage is RAM or cache memory).

Regarding claims 15, 16, 41, and 42, if the main web page (in which the advertisement is embedded) is closed, the advertisement is closed. This is a predefined event (web page closing is a predefined command that leads to advertisement termination). The closing of the web page is an input from the user.

Regarding claims 17, 18, 43, and 44, Merriman teaches the messages as being advertisements. Since the advertisements contain image data, this reads on entertainment components as well.

Regarding claims 24 and 46, Merriman teaches the ad database as storing multiple advertisements for different users (Column 4, Lines 56-64). If a different user views the web page, a different message will appear. This reads on executing more than one burst message.

4. **Claims 20 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Cezar (U.S. Patent No. 6,161,127)**. Cezar teaches a system and method for generating messages to a website browser that includes all of the limitations recited in the above claims.

Regarding claims 20 and 21, Cezar teaches a web terminal computer, a web server that displays a stored website for a user, and an advertising server that stores a software component for generating burst messages (to be played list) as well as burst messages themselves and sends the data to the web terminal (Abstract). The web server inherently identifies the web terminal by an IP address (otherwise, it would not know where to send the display page after receiving the request for the display page).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4, 25, 28, 29, 30, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (U.S. Patent No. 5,948,061).

Regarding claims 4, 25, 29, and 30, Merriman does not specify the generated messages downloading while no data is being downloaded from the web server. Official notice is taken that interstitial content is old and well-known in the web-advertising art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide 2 separate contents downloaded close to the same time interstitially so that the loading of the webpage will not hinder the load-time of the advertisement, and vice versa.

Regarding claim 28, Merriman does not specify the message as being JavaScript or VBS script. Official notice is taken that JavaScript and Visual Basic Script are both old and well-known in the art of web programming. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create the message using whatever language with which the programmer is most comfortable.

Regarding claim 39, Merriman does not specify the web terminal as being able to execute a DHTML page. Official notice is taken that DHTML is old and well-known in the art of web-programming. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a web terminal that could display DHTML pages so users are not limited in what they may view online.

6. Claims 19 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (U.S. Patent No. 5,948,061) in view of Inala (U.S. Patent No. 6,442,590).

Regarding claims 19 and 45, Merriman does not specify the generated message as containing chat components. Inala teaches an example of an embedded chat program (Figure 2, Reference 47). It would have been obvious to one having ordinary skill in the art at the time the invention was made to offer chat components in a generated embedded website message. This would allow for immediate feedback from and interaction with the user.

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cezar (U.S. Patent No. 6,161,127) in view of LaJoie (U.S. Patent No. 5,850,218).

Regarding claim 38, Cezar does not specify a web terminal as being a set-top box. LaJoie teaches a set-top box that is capable of browsing the Internet (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made for the user to browse the Internet over whichever web terminal is most convenient or most available to them.

8. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cezar (U.S. Patent No. 6,161,127).

Regarding claim 23, Cezar does not specify the web terminal as being able to execute a DHTML page. Official notice is taken that DHTML is old and well-known in

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the art of web-programming. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a web terminal that could display DHTML pages so users are not limited in what they may view online.

9. **Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (U.S. Patent No. 5,948,061) in view of LaJoie (U.S. Patent No. 5,850,218).**

Regarding claim 38, Merriman does not specify a web terminal as being a set-top box. LaJoie teaches a set-top box that is capable of browsing the Internet (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made for the user to browse the Internet over whichever web terminal is most convenient or most available to them.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

With regard to the information supplied in Applicant's recent affidavit of an advertisement floating across the screen of a website and coming to rest halfway, Examiner submits the following reference:

WO 97/35280 to Gever

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JEFFREY D. CARLSON
PRIMARY EXAMINER